

REMARKS

The Rejection of Claim 1:

Claim 1 stands rejected under 35 USC 103(a) as being unpatentable over Kinjo (5,978,100) in view of Ueda (6,714,314). The rejection is respectfully traversed. The claim sets forth a method that includes the steps of producing a "main subject belief map" and of using the main subject belief map "to produce a modified digital image." Neither of the quoted passages are found in either Kinjo or Ueda.

According to the disclosure of the present application, a main subject belief map is a probabilistic map (not binary) indicating (1) where the likely main subject is located and (2) how likely it is that this location is true. The main subject belief map is formed by use of a calculated gradient of "belief values". In turn, the gradient of belief values are related to the confidence that a particular image region is the main subject rather than a background subject. See pg. 5, line 28 through pg. 6, line 4.

Thus, we see that the phrase "main subject belief map" as used in the present claims is defined by the specification and forms an element of the claims. Specific examples of how a main subject belief map is determined are spread throughout the specification. See for example the paragraph starting at page 7, line 16; the paragraph starting at page 8, line 11; and the paragraph starting at page 9, line 1.

While Kinjo does teach the extraction of a main portion to a display from the resultant image, his patent does not disclose "employing a main subject belief map to produce a modified digital image" because the "main portion" in Kinjo is different from the "main subject belief map" in the present invention as that phrase is defined in the present specification.

In Kinjo's FIG. 2, it is clear that his term "main portion" refers exclusively to the face regions in an image. This is evidenced by his employment of extracting unit 56₁ through extracting unit 56_n to feed into a facial-region determining unit 58. Facial-region determining unit 58 then controls exposure based on the result of determination of facial regions. Furthermore, referring to Kinjo's FIG. 5, each of the extracting units is directed specifically at providing an indication of face candidate region. They combine to

produce an eventually binary mask showing the region determined to be facial region. Kinjo makes the fact clear (column 20, lines 31-41) that all the extraction methods, as well as the weighting coefficients for combining them, are based on "various face candidate regions".

Kinjo's results extraction by the Extraction Units of his FIG. 5 is a binary mask of where faces are and where faces are not. In contrast, the "main subject belief map" of the present invention is a probabilistic map (not binary) indicating where the likely main subject is and how likely it is, regardless of whether it is a face or not.

Kinjo uses "probability" only to determine a facial region, but discards the "probability" value once the facial region is determined, and then "exposure is calculated by using the photometric data on R,G,B of the facial region determined earlier" (column 22, lines 18-30). In contrast, the belief values in the "main subject belief map" of the present invention are incorporated in modifying the original digital image.

The Examiner's statement of what is disclosed by Kinjo does not reflect an understanding of what is claimed. Kinjo fails to disclose the steps of producing a "main subject belief map" and using the main subject belief map "to produce a modified digital image." Ueda fails to disclose, in conceptual terms, the information undisclosed by the Kinjo. Therefore, assuming *arguendo* that the references might be capable of combination, there is at least one limitation in the claimed invention that is not disclosed by the references, individually or in combination. "Each element of a claim is material." *Ashland Oil, Inc. v. Delta Resins & Refractories, Inc.*, 227 USPQ 657,666 (Fed. Cir., 1985)

The Rejection of Claim 2:

Claim 2 stands rejected under 35 USC 103(a) as being unpatentable over Kinjo in view of Ueda and further in view of Luo et al. (6,654,506). The Examiner will note that the inventive entity of Luo et al. is identical to the inventive entity of the present application. The application upon which Luo et al. (6,654,506) issued was commonly assigned, co-pending U.S. Patent Applications Serial No. 09/490,915 mentioned in the CROSS REFERENCE TO RELATED APPLICATIONS section of the present application.

The Rejection of Claims 3 and 6:

Claims 3 and 6 stands rejected under 35 USC 103(a) as being unpatentable over Kinjo in view of Ueda and further in view of Ikenoue et al. (6,038,011). Claims 3 and 6 depend from Claim 1 and are allowable therewith. Further, Ikenoue et al. not only fails to disclose the information undisclosed by the Kinjo, but the passage referred to by the Examiner wherein Ikenoue et al. notes an "emphasizing step" is taken completely out of context. After indicating the rejection is under 35 USC 103, the Examiner must set forth an explanation why such proposed modification would be obvious. In rejecting claims under 35 U.S.C. 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. In so doing, the Examiner is expected to make factual determinations and to provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. These showings by the Examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness.

The Rejection of Claim 4:

Claim 4 stands rejected under 35 USC 103(a) as being unpatentable over Kinjo in view of Ueda and Ikenoue et al. and further in view of Feldman (5,333,549). Claim 4 depends from Claim 3 and is allowable therewith. Feldman is relied on for teaching a prominent image in color with a black and white background. Feldman relates to the production of printed images on foil-covered surfaces such as for sports figure cards, makeup and perfume packaging, playing cards, greeting cards, tags, signs and badges. There is nothing in Feldman that would suggest its use in the production of photographic processing.

The Examiner "cannot pick and choose among individual parts of assorted prior art references "as a mosaic to recreate a facsimile of the claimed invention," *Akzo N.V. v. U.S. international Trade Commission*, 1 USPQ2d 1241, 1246 (Fed. Cir. 1986). Thus, it is incorrect for the Examiner to pick and choose various components from the prior art without indicating why it would have been obvious to one of ordinary skill in the art to have combined all these various elements together.

To support the conclusion that the claimed combination is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

The Rejection of Claim 5:

Claim 5 stands rejected under 35 USC 103(a) as being unpatentable over Kinjo in view of Ueda and further in view of Ikenoue et al. and further in view of Edgar (5,611,027). Claim 5 depends from Claim 3 and is allowable therewith.

Edgar is relied upon to teach a spotlight effect. However, the Examiner may not use applicant's claims as a guide or road map to selectively pick or choose elements or concepts from the various references. Although the prior art might be modifiable in the manner suggested by the Examiner, this does not make the modification obvious and there is no motivation to one skilled in the art to modify the subject matter of Kinjo in light of the teachings of Edgar, unless the prior art suggested the desirability of the modification. It is impermissible to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. In *re Fritch*, 23 USPQ2d 1780 (CAFC 1992)

The Rejection of Claims 7 and 8:

Claims 7 and 8 stand rejected under 35 USC 103(a) as being unpatentable over Kinjo in view of Ueda and further in view of McConnell et al. The rejection is traversed.

McConnell et al. is cited as disclosing the alteration of pixel values of the main subject or background. However, the Examiner must be sure that it is the references which suggest their combination and not applicant's specification or claims. "In establishing a *prima facie* case of obviousness under 35 USC 103, it is incumbent upon the examiner to provide a reason *why* one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. To this end, the requisite motivation must stem from some teaching, suggestion, or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from appellants' disclosure." *Ex parte Nesbit* 25 USPQ2d 1817,

1819, (BPAI 1992), citing *Ex parte Clapp*, 227 USPQ, 972 (BPAI 1985) and *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (CAFC 1988).

Conclusions:

For the reasons set forth above, it is believed that the application is in condition for allowance. Accordingly, reconsideration and favorable action are respectfully requested. Applicants respectfully submit that it would not have been obvious to one of ordinary skill in the art to have combined all of the various features of the independent claim 1. Applicants further submit that the above-listed dependent claims also patentably distinguish over the prior art.

The Commissioner is hereby authorized to charge any fees in connection with this communication to Eastman Kodak Company Deposit Account No. 05-0225. *A duplicate copy of this communication is enclosed.*

Respectfully submitted,

A handwritten signature in dark ink, appearing to read 'Mark G. Bocchetti', with a stylized flourish extending from the end.

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